



IFW

Docket No.: 0760-0337PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Hisashi NARIMATSU et al.

Application No.: 10/507,421

Filed: March 11, 2005

For: NOVEL N-ACETYLGLUCOSAMINE
TRANSFERASE, NUCLEIC ACID ENCODING
THE SAME AND USE THEREOF FOR
DIAGNOSIS OF CANCERS AND/OR
TUMORS

Confirmation No.: 6315

Art Unit: 1652

Examiner: I.H. CHOWDHURY

INFORMATION DISCLOSURE STATEMENT
(SUBMISSION AFTER FILING OF AN APPLICATION BUT BEFORE FINAL
REJECTION OR NOTICE OF ALLOWANCE OR CONCURRENTLY WITH A RULE
1.114 RCE APPLICATION)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §§ 1.97 and 1.98, applicant(s) hereby submit(s) an Information Disclosure Statement for consideration by the Examiner.

I. LIST OF PATENTS, PUBLICATIONS OR OTHER INFORMATION

The patents, publications, or other information submitted for consideration by the Office are listed on the PTO-SB08(s), attached hereto.

II. COPIES

- ☒ a. Copies of cited U.S. patents and patent application publications are not included.
Copies of foreign patent documents and non-patent literature are included.

☐ b. Some or all of the documents listed on the PTO-SB08 are not enclosed because they were cited in the International Search Report and copies should already be in the PTO file. If copies are needed, please contact the undersigned.

☐ c. REFERENCES PREVIOUSLY CITED OR SUBMITTED - Pursuant to 37 C.F.R. §1.98(d), consideration of information listed on the PTO-SB08 form(s) is requested since any patents, publications, or other information which are listed on the PTO-SB08 form(s) but for which copies are not enclosed herewith, were previously cited by or submitted to the PTO in one of the following applications which has been relied upon for an earlier filing date under 35 U.S.C. § 120:

U.S. Appl. No(s) and U.S. Filing Date

III. CONCISE EXPLANATION OF THE RELEVANCE

(check at least one box)

☒ a. DOCUMENTS IN THE ENGLISH LANGUAGE - The patents, publications, or other information listed on the attached PTO SB08 are in the English language and therefore, do not require a statement of relevancy.

☐ b. DOCUMENTS NOT IN THE ENGLISH LANGUAGE - A concise explanation of the relevance of all patents, publications, or other information listed that is not in the English language is as follows:

☒ c. ENGLISH LANGUAGE SEARCH REPORT - An English language version of the search report or action that indicates the degree of relevance found by the foreign office is attached, thereby satisfying the requirement for a concise explanation. See MPEP 609(III)(A)(3).

☐ d. OTHER - The following additional information is provided for the Examiner's consideration.

IV. FEES (check one box)

☐ a. This Information Disclosure Statement is being filed concurrently with the filing of a new patent application; therefore, no fee is required.

☐ b. This Information Disclosure Statement is being filed concurrent with the filing of a continuation-in-part, continuation, or divisional patent application; therefore, no fee is required.

☐ c. This Information Disclosure Statement is being filed within three months of the filing date of a national application (37 C.F.R. § 1.97(b)(1)). No fee or statement is required.
(This section is not to be used with RCE's.)

☐ d. This Information Disclosure Statement is being filed within three months of the date of entry of the national stage as set forth in § 1.491 in an international application (37 C.F.R. § 1.97(b)(2)). No fee or statement is required.

☐ e. This Information Disclosure Statement is being filed concurrently with the filing of a Request for Continued Examination under § 1.114 (37 C.F.R. § 1.97(b)(4)). No fee or statement is required.

☒ f. This Information Disclosure Statement is being filed before the mailing date of a first Action on the merits (37 C.F.R. § 1.97(b)(3)). No fee or statement is required. In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the statement under 37 C.F.R. § 1.97(e) below, or, if no statement has been made, charge our deposit account for the fee as required by 37 C.F.R. § 1.17(p).

☐ g. This Information Disclosure Statement is being filed before the mailing date of a Final Office Action under 37 C.F.R. § 1.113 (See 37 C.F.R. § 1.97(c)(1)) or before the mailing date of a Notice of Allowance under 37 C.F.R. § 1.311 (See 37 C.F.R. § 1.97(c)(2)).

☐ No statement; therefore, a fee as required by 37 C.F.R. § 1.17(p) is attached.

or

☐ See the statement below. No fee is required.

V. STATEMENT UNDER 37 C.F.R. § 1.97(e)

(check only one box)

The undersigned hereby states that:

☐ a. **Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than 30 days prior to the filing of this IDS; or**

☐ b. Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS; or

☐ c. No item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.

☐ d. Some of the items of information were cited in a communication from a foreign Patent Office. As to this information, the undersigned states that each item of information contained in the IDS was first cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby states that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application and, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

VI. PAYMENT OF FEES (check one box)

☐ The required fee is listed on the attached Fee Transmittal.

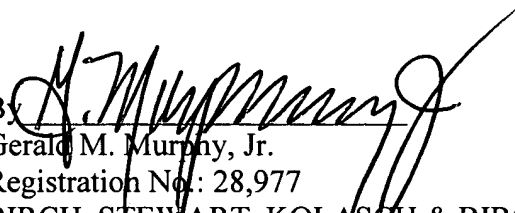
☒ No fee is required.

If the Examiner has any questions concerning this IDS, he/she is requested to contact the undersigned. If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule and charge the appropriate fee to Deposit Account No. 02-2448.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: FEB 21 2006

Respectfully submitted,


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Attachment(s):

- ☒ PTO-SB08
- ☒ Documents
- ☒ Foreign Search Report



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Substitute for form 1449A/B/PTO			Complete if Known		
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)			Application Number	10/507,421-Conf. #6315	
			Filing Date	March 11, 2005	
			First Named Inventor	Hisashi NARIMATSU	
			Art Unit	1652	
			Examiner Name	I.H. CHOWDHURY	
Sheet	1	of	2	Attorney Docket Number	0760-0337PUS1

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				
	BA	WO-02/055683-A2 ✓	07-18-2002			
	BB	WO-01/075067-A3 ✓	10-11-2001			
	BC	WO-2004/039976-A1 ✓	05-13-2004			

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS					
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.			T ²
	CA	Iwai T ET AL: "Molecular cloning and characterization of a novel UDP-GlcNAc: GalNAc-pyridyltransferase β 1, 3-N-acetylglucosaminyltransferase (β 3Gn-T6), an enzyme synthesizing the core 3 structure of O-glycans" JOURNAL OF BIOLOGICAL CHEMISTRY, vol.277, no.15, pages 12802-12809, XP002961055 ISSN: 0021-9258			
	CB	DATABASE EMBL `Online! 14 December 1999, "Homo sapiens BAC clone RP11-56215 from 2, complete sequence." XP002360645			
	CC	DATABASE Geneseq `Online! 18 February 2002, "Novel human diagnostic protein #20242." XP002360646			
	CD	DATABASE EMBL `Online! 22 February 2000, "Homo sapiens cDNA FLJ20763 fis, clone COL09911," XP002360648			
	CE	KATAOKA K ET AL: "Screening for genes involved in tissue invasion based on placenta formation and cancer cell lines with low and high metastatic potential." vol.163-, no.2, 26 February 2001, pages 213-219, XP002360624			
	CF	DATABASE Geneseq `Online! 26 June 2001, "Human cDNA clone (5'-primer) SEQ ID NO:2089." XP002360649			
	CG	DATABASE EMBL `Online! 25 June 2002, "Homo sapiens beta 1, 3-N-acetylglucosaminyltransferase 7 mRNA, complete cds." XP002360650			
	CH	KEN KATAOKA ET AL: "A novel β 1, 3-N-acetylglucosaminyltransferase involved in invasion of cancer cells as assayed in vitro" BIOCHEMICAL AND BIOPHYSICAL RESEARCH COMMUNICATIONS, ACADEMIC PRESS, SAN DIEGO, CA, US, vol.294, 2002, pages 843-848, XP002975891 ISSN: 0006-291X			
	CI	DATABASE Geneseq `Online! 20 May 2003, "Human NOV106a protein." XP002360651			
	CJ	DATABASE Geneseq `Online! 20 May 2003, "Human NOV106a cDNA." XP002360652			
	CK	DATABASE Geneseq `Online! 26 February 2003, "Human cDNA #848 differentially expressed in activated vascular tissue." XP002360653			
	CL	DATABASE EMBL `Online! 3 February 2004, "Sequence 23746 from Patent WO02068579."			
Examiner Signature				Date Considered	



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		Examiner Name	I.H. CHOWDHURY		
Sheet	2	of	2	Attorney Docket Number	0760-0337PUS1

		XP002360654	
	CM	DATABASE Geneseq `Online! 4 November 2004, "Amino acid sequence of human MAPCAX orthologue #5." XP002360655	
	CN	DATABASE Geneseq `Online! 7 October 2004, "Novel human protein sequence #1907." XP002360656	
	CO	DATABASE Geneseq `Online! 12 February 2004, "Human polypeptide sequence SEQ ID No:1375." XP002360657	
	CP	DATABASE Geneseq `Online! 12 February 2004, " Human contig polypeptide sequence SEQ ID No:2684." XP002360658	
	CQ	DATABASE Geneseq `Online! 12 February 2004, "Human polynucleotide sequence SEQ ID No:334." XP002360659	
	CR	DATABASE Geneseq `Online! 12 February 2004, " Human contig polynucleotide sequence SEQ ID No:2232." XP002360660	
	CS	DATABASE Geneseq `Online! 21 October 2004, "Breast cancer prognosis marker #220." XP002360661	
	CT	SEKO A ET AL: "β1, 3-N-Acetylglucosaminyltransferase-7 (β3Gn-T7) acts efficiently on keratan sulfate-related glycans" FEBS LETTERS, ELSEVIER, AMSTERDAM, NL, vol.556, no.1-3, 2 January 2004, pages 216-220, XP004483233 ISSN: 0014-5793	
	CU	DATABASE Geneseq `Online! 13 February 2002, DNA encoding novel human diagnostic protein #20242." XP002360647	

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
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